

Remarks/Arguments

Reconsideration and allowance of the above identified patent application are respectfully requested. The referenced application addresses cyano- substituted thiophenes, compositions containing such compounds and methods of treatment. The Communication dated June 24, 2005 indicated that the status of claims 17 and 18 required an indication that the claims were withdrawn from consideration by the Examiner. This has been provided.

The application was the subject of a restriction requirement dated December 10, 2004. The restriction was traversed. The restriction requirement has been maintained, with an indication that rejoinder may be permitted upon a finding that product claims are in allowable condition. Applicants have amended the claims dependency to preserve the right of rejoinder, and have added claims as appropriate.

The Examiner objected to claims 11 and 12 as being dependent upon a rejected base claim, and indicated that they would be allowable if rewritten in independent form. This has been done, presented as claims 19 and 20. Claims 1-5, 7-9 and 13 were rejected under 102(a) for anticipation by Al-Omron et al. (Al-Omron). Claims 1, 5-9 and 16 were rejected under 102(e) for anticipation by Cao, et al (Cao). Claims 1-10 and 13-16 were rejected for obviousness under 103(a) over Cao, Hagen, et al. (Hagen), and Kawai, et al. (Kawai) each taken alone and in combination.

An obviousness-type double patentability rejection has been raised over U.S. Application no. 10/706,695, specifically claim 14, wherein R¹ is allyl, R² is allyl substituted with R⁶ (e.g., trifluoromethyl) and R³ is allyl. Applicants request that this be held in obedience pending a determination that an allowable composition claim exists in the present application. Applicants will traverse the requirement or take other appropriate action at that time.

Applicants urge that motivation to "prepare products" in view of the co-pending application is not properly at issue, since Applicants could combine the applications or abandon one or the other. The inquiry should focus on whether the claims of one application might unlawfully extend the monopoly on an obvious group of compounds claimed in a previous application if both applications, upon grant, would not expire at the same time. Here, Applicant does not believe that

granting both would unlawfully extend the term of either patent, such that a terminal disclaimer should be required.

Applicants respectfully traverse the anticipation and obviousness rejections as set forth below.

Claims 1-5 and 10-13 have been cancelled rendering the rejection of these claims moot. Claims 19 and 20 have replaced claims 11 and 12. Claims 16-18 have been amended to reflect dependency from new claim 19, and claims 21 – 23 were added to reflect dependency from new claim 20. As such, claim dependency has been adjusted to permit rejoinder upon the Examiner making a finding of patentable subject matter.

Regarding the obviousness rejections, the compounds of the claims are not obvious in view of Cao, Hagen or Kawai, taken individually or in combination. Cao relates to inhibitors of ROCK and other kinases. Hagen relates to herbicides and Kawai relates to compounds purportedly useful to suppress the production of TNF-alpha. Hence, they are not related to glucagon receptor antagonism, as this term is understood by those of ordinary skill. As the Examiner has already determined with respect to claims 11 and 12, these claims, now re-written as claims 19 and 20, address patentable subject matter.

Based upon the foregoing, reconsideration and allowance are approximate and are respectfully requested. If the Examiner has any questions, she is requested to telephone the undersigned.

Respectfully submitted,

By



Richard C. Billups
Reg. No. 31,916
Attorney for Applicants
MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
Tel. No. (732) 594-4683

Date: June 29, 2005